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10/007,355	11/07/2001	Mitchell D. Eggers	PW 083022 272515	3570

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Pillsbury Winthrop LLP
Intellectual Property Group
50 Fremont Street
P.O. Box 7880
San Francisco, CA 94105

EXAMINER

ALEXANDER, LYLE

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1743

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED
AUG 17 2007
GROUP 1700

Application Number: 10/007,355
Filing Date: November 07, 2001
Appellant(s): EGGERS, MITCHELL D.

Mr. Anthony G. Smyth
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/4/07 appealing from the Office action mailed 12/8/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1-40 and 58-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33,

Art Unit: 1743

58-62 and 94-101 of copending Application No. 10/005,529, claims 1-64 and 86-114 of copending Application No. 10/150,771 and claims 1-30 of copending Application No. 10/150,770 .

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 01/31333	Milosavijevic	5-2001
WO 01/31317	Hogan	5-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-40 and 58-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33,

58-62 and 94-101 of copending Application No. 10/005,529, claims 1-64 and 86-114 of copending Application No. 10/150,771 and claims 1-30 of copending Application No. 10/150,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a sample carrier comprising a structural array having a plurality of node, optically labeled identification means and means to control/locate each sample.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-40 and 58-69 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Milosavljevic et al.

Milosavljevic et al. teach a structural array with a plurality of sample nodes that are optically coded permitting a predetermined spatial relationship between the nodes and the multi-well plate.

The 10/6/05 amendments add the limitations that each sample node is "discrete". The Office maintains the cited prior art teaches sample placement nodes that do not mix with other applied samples and meet the claimed "discrete" limitation.

Claims 1-14,20-35, 58-66 and 69 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hogan (WO 01/31317 cited by Applicant).

Hogan teaches a biological retrieval system employing a DNA repository(10) that includes an identification code(28) readable by the robotic assembly(16) and is correlated with medical information in database(14) about the donor. The robotic system(16) is activated to retrieve a sample and punch head assembly(72) punches out a portion of the sample on the substrate(24) into a multi-well tray for subsequent biological analysis. Page 4 teaches the substrate(24) upon which the sample is placed is a paper material and has been read on the claimed "solid", "porous", and "cellulose" support medium. Further, indicia(28) is taught as "bar code for identification of an OCR or bar code scanner, respectively, or other machine readable indicia. The claimed nodes have been read on the sample applied to the substrate(24) and the claimed array on the taught multi-well tray. Finally, page 4 teaches the substrate(24) may be treated with chemical compounds.

The 10/6/05 amendments add the limitations that each sample node is "discrete". The Office maintains the cited prior art teaches sample placement nodes that do not mix with other applied samples and meet the claimed "discrete" limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-19, 36-40 and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

See Hogan *supra*.

Hogan is silent to the claimed support medium being made of a polymer such as polystyrene, the derivatized surface and the charge of the surface of the support.

The court decided In re Leshin (125 USPQ 416) "mere selection of a plastic ... on the basis of suitability for the intended use, would be entirely obvious". Polystyrene is notoriously well known in the art as being inexpensive, malleable, relatively inert and

Art Unit: 1743

commercially available. It would have been within the skill of the art to modify Hogan and use a polymer such as polystyrene as a support to gain the above advantages and in view of Leshin.

In the absence of better defining what is intended structure is intended by “derivatized” and the surface having a positive or negative charge, the Office will consider the choice of surface a result effective variable. A result effective variable is one that has predictable and well-known results. The choice of surface derivatization and the subsequent positive/negative charge would have the well-known and expected result of bonding the analyte molecules of the opposite charge and repelling analytes of the same charge. Thus, one designing an experiment would select the surface charge based upon the analyte of interest and the repulsion of interfering compounds. It would have been within the skill of the art to modify Hogan and derivatize the surface selecting a positive or negative charge as optimization of a result effective variable which is obvious here and within the skill of the art (see In re Boesch 205 USPQ 215).

(10) Response to Argument

Independent Claims 1 and 58 Patentable Define Over The Prior Art

Appellant states independent claims 1 and 58 define over Milosavijevic ('333) and Hogan('317) because these references fail to teach the claimed plurality of removably attached discrete sample nodes. Appellant also states the Office have improperly interpreted the claimed term “discrete sample node”.

Milosavijevic ('333) and Hogan('317) teach punching out a dried biological sample from a discrete portion of the sheet that has been read on the claimed "... discrete sample nodes being removable attached...". Presumable, Appellant is arguing the punch out of the sample cannot be read on the claimed "removable attachment". The prior art teach removal of the sample from the sheet (which has been read on the claimed nodes) that is indistinguishable from the instant claim language.

Appellant state node means "point of origin" and "discrete" means separated entities. The Office maintains the cited prior art teaches portions of the sheet where the sample is applied. Each portion is separated from the adjacent portion to prevent the mixing of the sample. The Office maintains the prior art clearly teach "discrete nodes" that are consistent with Appellant's definitions above.

Appellant figure 4A and page 28 lines 24-30 teaches the structural arrays(420A-C) are arranged in alignment with multi-well plate(430) negate the characterization of the cited prior art by the Office. Milosavijevic and Hogan teach indistinguishable devices where sample are punched out of a substrate and deposited into a multi-well plate.

Independent Claim 20 Patentably Defines Over The Prior Art

Appellant states the cited prior art fails to teach the claimed "attachment points" , "discrete nodes" and a "plurality of structural arrays". The Office maintains the cited prior art teaches application of the samples to discrete portion as discussed above and has been properly read on the claimed "attachment points" and "discrete nodes". Milosavijevic teach in claim "one or more microarrays" and Hogan teach in figure a

plurality of substrate upon which the sample is applied. The Office maintains these teaching clearly anticipated the instant claims.

The Examiner Erred In Disregarding Declaration Of An Inventor Of The Cited Prior Art

Appellant submitted a Declaration on 9/30/05 from Michael Hogan, who is a co-inventor of both pieces of cited prior art. The substantive portion of the Declaration is the single sentence "I have reviewed the specification and claims of the '355 Application and have concluded that the "attachment points" recited in independent claims 1,20 and 58 of the present '355 Application are not described in the '317 or '333 PCT Patent Application".

Mr. Hogan's conclusions are held in high esteem and have been properly considered. However, there is a lack of factual and irrefutable evidence in the Declaration and it has been given the proper weight as the opinions of Mr. Hogan. The court decided *In re Chilowsky*, 306 F.2d 908,134 USPQ 515 (CCPA 1962) that expert opinion is not entitled to any weight. Mr. Hogan conclusions do not provide any factual evidence and have been properly considered in light of the above court decision.

Appellant states Mr. Hogan's Declaration states he has reviewed the specification and claims. The Office maintains the review does not constitute factual evidence and has been given the appropriate weight.

Appellant references figures and portions of the specification. These remarks are not commensurate in scope with the 10/3/05 Declaration that makes no mention of these particulars.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

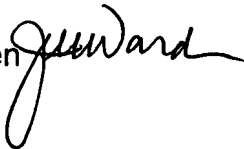
Lyle A. Alexander



**LYLE A. ALEXANDER
PRIMARY EXAMINER**

Conferees:

Jill Warden



ROMULO DELMENDO